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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,239	01/02/2002	Joseph F. Cihula	42390P13066	6665
8791	7590	05/21/2004	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD, SEVENTH FLOOR LOS ANGELES, CA 90025			ALAM, SHAHID AL	
			ART UNIT	PAPER NUMBER
			2172	

DATE MAILED: 05/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,239

Applicant(s)

CIHULA ET AL.

Examiner

Shahid Al Alam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-46 and 49-63 is/are rejected.
- 7) ☒ Claim(s) 12,13,47 and 48 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1 – 63 are pending in this Office action.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 8 and 19 recite the limitation "A method" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 29 recites the limitation "A system" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claims 36, 43 and 54 recite the limitation "A article of manufacture" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 63 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

MPEP 2106.II.A

A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Claims 1 – 63, in view of the above cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 5, 7, 36 – 40 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 6,055,636 issued to Stephen Hillier et al. (“Hillier”).

With respect to claim 1, Hillier teaches a method comprising: reading distinguished name data from a signed certificate received from a certificate authority (column 5, lines 45 – 50); and

searching a data structure to identify a certificate signing request associated with the signed certificate (column 3, lines 29 – 31), the identified certificate signing request corresponding to the read distinguished name data (column 2, lines 38 – 39 and 49 – 54).

As to claim 2, identifying a key pair associated with the signed certificate (column 2, lines 49 – 54).

As to claim 3, the read distinguished name data comprising all of the distinguished name data contained in the signed certificate (column 5, lines 18 – 22).

As to claim 4, the identified certificate signing request corresponding to a portion of the read distinguished name data (column 5, lines 18 – 22).

As to claim 5, importing the signed certificate to a server associated with the identified certificate signing request (column 3, lines 29 – 31).

As to claim 7, identifying at least two certificate signing requests associated with the signed certificate (column 3, lines 29 – 45).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 6 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillier and in view of "How To: Enable SSL for All Customers Who Interact with Your Web Site."

As to claim 6, Hillier teaches the secure communication device includes a security activation module, . . . an application programmatic interface (see column 3,

lines 4 – 14). Hillier does not explicitly teach the signed certificate is imported to a device that performs SSL processing on behalf of the server as claimed.

“HOW TO: Enable SSL” discloses claimed signed certificate is imported to a device that performs SSL processing on behalf of the server (To enable SSL server certificate verification, and to provide the level of security that your customers desire, you should obtain a certificate from a third-party CA. Certificates that are issued to your organization by a third-party CA are typically tied to the Web server, and more specifically to the Web site to which you to bind SSL. You can create your own certificate with the Internet Information Services (IIS) server, but if you do so, your clients must implicitly trust you as the certificate authority).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine “HOW TO: Enable SSL” with Hillier to provide the level of security to users.

Claims 36 – 42 are essentially the same as claims 1 – 7 except that it set forth the claimed invention as an article of manufacture rather than a method and rejected for the same reasons as applied hereinabove.

8. Claims 8 – 11, 14 – 18, 19 – 28, 29 – 35, 43 – 46, 49 – 53 and 54 – 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillier and further in view of U.S. Patent Number 6,067,623 issued to George Blakley et al. (“Blakley”).

With respect to claim 8, Hillier teaches distinguished name data for each of a plurality of certificate signing requests (column 5, lines 45 – 50); extracting distinguished name data from a signed certificate received from a certificate authority (column 3, lines 29 – 33); and comparing the extracted distinguished name data to identify a certificate

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signing request associated with the signed certificate from the plurality of certificate signing requests (column 2, lines 38 – 39, 49 – 54 and column 5, lines 1 – 9).

Hillier does not explicitly teach providing a mapping table as claimed.

Blakley teaches claimed mapping table (see column 4, lines 18 – 49 and column 5, lines 7 – 16).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Blakley with Hillier to maintain client enterprise resource authorization control at the middle tier server. It would have been obvious to enable single client authentication with access to multiple enterprise resources each having individual authorization mechanisms (column 3, lines 24 – 30; Blakley).

As to claim 9, at least a common name for each of the plurality of certificate signing requests (column 3, lines 29 – 33; Hillier) .

As to claim 10, the extracted distinguished name data comprising all of the distinguished name data contained in the signed certificate (column 5, lines 18 – 22).

As to claim 11, the extracted distinguished name data comprising a common name (column 5, lines 18 – 22).

As to claim 14, comparing the extracted distinguished name data with the mapping table data to identify at least two certificate signing requests from the plurality of certificate signing requests (column 2, lines 38 – 39, 49 – 54 and column 5, lines 1 – 9); and determining which of the at least two certificate signing requests is associated with the signed certificate (column 3, lines 29 – 45).

As to claim 15, performing a second search of the mapping table data to determine which of the at least two certificate signing requests is associated with the signed certificate (column 3, lines 29 – 45).

As to claim 16, importing the signed certificate to a server associated with the identified certificate signing request (column 3, lines 29 – 33).

As to claim 18, identifying at least two certificate signing requests associated with the signed certificate (column 3, lines 29 – 45).

With respect to claim 19, Hillier teaches generating a certificate signing request, the certificate signing request including distinguished name data (column 5, lines 45 – 50);

transmitting the certificate signing request to a certificate authority (column 1, lines 64 – 65);

receiving a signed certificate from the certificate authority, the signed certificate including distinguished name data (column 1, lines 58 – 60);

extracting the distinguished name data from the signed certificate (column 2, lines 45 – 47 and column 3, lines 29 – 33); and comparing the extracted distinguished name data with the stored distinguished name data contained in the mapping table to identify the certificate signing request (column 2, lines 38 – 39, 49 – 54 and column 5, lines 1 – 9).

Hillier does not explicitly teach providing a mapping table as claimed.

Blakley teaches claimed mapping table (see column 4, lines 18 – 49 and column 5, lines 7 – 16).

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It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Blakley with Hillier to maintain client enterprise resource authorization control at the middle tier server. It would have been obvious to enable single client authentication with access to multiple enterprise resources each having individual authorization mechanisms (column 3, lines 24 – 30; Blakley).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hillier and Blakley and further in view of "How To: Enable SSL for All Customers Who Interact with Your Web Site." ("How To: Enable SSL").

As to claim 17, Hillier teaches the secure communication device includes a security activation module, . . . an application programmatic interface (see column 3, lines 4 – 14). Hillier and Blakley do not explicitly teach the signed certificate is imported to a device that performs SSL processing on behalf of the server as claimed.

"HOW TO: Enable SSL" discloses claimed signed certificate is imported to a device that performs SSL processing on behalf of the server (To enable SSL server certificate verification, and to provide the level of security that your customers desire, you should obtain a certificate from a third-party CA. Certificates that are issued to your organization by a third-party CA are typically tied to the Web server, and more specifically to the Web site to which you to bind SSL. You can create your own certificate with the Internet Information Services (IIS) server, but if you do so, your clients must implicitly trust you as the certificate authority).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine "HOW TO: Enable SSL" with Hillier to provide the level of security to users.

The subject matter of claims 20 – 28 are rejected in the analysis above in claims 8 – 11, 14 – 19 and these claims are rejected on that basis.

Claims 29 – 35 are essentially the same as claims 8 – 11, 14 – 18 and 19 except that it sets forth the claimed invention as a system rather than a method and rejected for the same reasons as applied above.

Claims 43 – 46 and 49 – 53 are essentially the same as claims 8 – 11 and 14 – 18 except that it sets forth the claimed invention as an article of manufacture rather than a method and rejected for the same reasons as applied above.

Claims 54 – 63 are essentially the same as claims 8 – 11, 14 – 18 and 19 except that it sets forth the claimed invention as an article of manufacture rather than a method and rejected for the same reasons as applied above.

Allowable Subject Matter


9. Claims 12, 13, 47 and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (703) 305-2358. The examiner can normally be reached on Monday-Thursday 8:00 A.M. - 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shahid Al Alam
Primary Examiner
Art Unit 2172

17 May 2004